

REMARKS

Claims 4, 7-12, 22-24, 26-38 are currently pending. Claims 13-20 were previously withdrawn. Claims 1-3, 5-6, 21, and 25 are cancelled. Claims 4, 7, 8, 10-12, 22, 24, and 26 are currently amended. Claims 28-38 are currently added. Reconsideration of presently pending claims 4, 7-12, 22-24, 26-38 is respectfully requested in light of the above amendments and the following remarks.

Double Patenting Rejection

Claims 1, 11, 12, 21, and 23 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 22-24 of copending Application Number 10/799835 ("the '835 Application"). This rejection is respectfully traversed based a fundamental defect which is discussed below.

The defect is that, as to the claims of the present application, the double patenting rejection vaguely asserts that claims 1, 11, 12, 21, and 23 recite effectively the same invention as several of the claims of the '835 Application, but does not identify any specific correspondence. A proper double patenting rejection must set forth a one-to-one correspondence between a pending claim of the present application and a respective one of the claims of the '835 Application. For example, MPEP §804 explains,

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention in a claim in the patent.

The present Office Action does not meet these requirements. In particular, as to each of Claims 1, 11, 12, 21, and 23, the present Office Action fails to identify a specific corresponding claim in the '835 Application (i.e. "a claim in the patent compared to a claim in the application"), much less set forth the "differences between the inventions defined by the conflicting claims," still less set forth any "reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." For example, the rejection would need to establish that Claim A of the present application is obvious from patent Claim X, Claim B of the application is obvious from patent Claim Y, Claim C of the application is obvious from patent Claim Z, and so forth. The Office Action fails to do any of this. For at least this additional reason, it is respectfully submitted that the double patenting rejection should be withdrawn.

Rejections under 35 U.S.C. §101

Claim 21 has been cancelled and therefore, for at least this reason, this rejection is no longer applicable.

Rejections under 35 U.S.C. §102

Claims 1-6, 10, 21, and 24-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. App. Pub. No. 2005/0021040 to Bertagnoli ("the Bertagnoli application"). Independent claims 1 and 21 have been cancelled and their remaining dependent claims now depend from new claims 28 and 34, respectively (see discussion below).

The Office Action of October 19 stated, "[r]egarding claims 24-27, Bertagnoli discloses a first distracting arm (17) including a side wall with an elongated slot (see figure 2), an anchoring device (11), a connection projection (16)," Independent claim 24 as amended recites, inter alia, "a first distracting arm including a side wall through which an elongated slot extends, the

side wall surrounding an internal bore in communication with the elongated slot; an anchoring device adapted to receive a bone fastener and including a connecting projection sized to slide within the internal bore and adapted for pivotal motion within the elongated slot and through the side wall” These limitations are not disclosed in the Bertagnoli application. For example, the connection projection (26) of Bertagnoli is not sized to slide within an internal bore surrounded by the side wall.

New Claims

Claims 28-38 have been added. Independent claim 28 recites, inter alia, “a hollow shaft portion closed at a distal end and open at a proximal end to an elongated passage extending through a first set of opposite side walls of the first distraction arm and a pin extending across the elongated passage, between a second set of opposite side walls of the first distraction arm; and a first anchoring device including a connecting post and a pivot mechanism movably attached to the pin, wherein the pivot mechanism is movable about the pin between a first position in which the connecting post extends into the hollow shaft portion of the first distraction arm and a second position in which the connecting post extends out of the elongated passage.” Independent claim 34 recites, inter alia, “a first anchoring device movably engaged with the first distraction arm, the first anchoring device comprising “a first section including a connection post, having a distal end and a proximal end between which extends a second axis, the connection post slidable within the hollow bore and a second section including a through passage adapted to receive a vertebral fastener, the through passage including a first opening and a second opening between which extends a third axis, wherein the second axis remains parallel with the third axis as the first anchoring device movably engages the first distraction arm.”

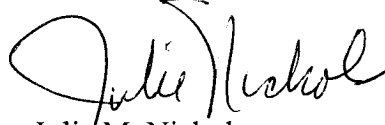
These limitations do not appear to be disclosed by the Bertagnoli application either alone or in combination with the references cited in the claim rejections under 35 U.S.C. §103.

Conclusion

It is clear from all of the foregoing that claims 4, 7-12, 22-24, 26-38 are in condition for allowance. The Examiner is invited to phone the Applicant's representative at number listed below to resolve any open issues which the Examiner has identified.

An early formal notice of allowance of claims 4, 7-12, 22-24, 26-38 is requested.

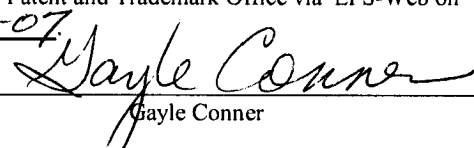
Respectfully submitted,



Julie M. Nickols
Registration No. 50,826

Dated: Jan 18, 2007

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972/739-8640
Facsimile: 214/200-0853
Client Matter No.: PC1077.00
Attorney Docket No.: 31132.237
Document No.: R-153354

<p align="center">Certificate of Service</p> <p>I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on <u>1-18-07</u>.</p> <p align="center"> _____ Gayle Conner</p>
--